

## REMARKS

Claims 4, 5, 21 and 37-44 are pending in the present application. The Examiner has withdrawn claims 38, 40 and 44 from consideration, as being drawn to the non-elected invention. In response to the first office action issued by the Examiner, Applicant cancelled claims 4, 5, 39, 41 and 42. Therefore, 21, 37 and 43 are presently under consideration.

### Withdrawal of rejections

Applicant gratefully acknowledges the Examiner's withdrawal of all previous rejections except for the rejection under 35 U.S.C. § 102(e), as set forth below.

### Amendment of inventorship

Applicant has submitted a second amendment herewith to correct the inventorship of the present patent application. Due to the amendment of claims during the prosecution of the present application, the invention of Robert Friesel is no longer claimed in the claims currently under consideration. Therefore, Applicant has submitted the second amendment herewith in compliance with 37 C.F.R. § 1.48(b), indicating that Volkhard Lindner is properly the sole inventor of the claims currently under consideration.

### Rejections Under 35 U.S.C. § 102(e)

The Examiner maintained the rejection of claims 21, 37 and 43 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application publication number US20040146862 of Mack et al. ("Mack"). It is the Examiner's view that the Inventor's declaration submitted under 37 C.F.R. § 1.131 was insufficient to overcome the anticipatory rejection. Applicant respectfully submits that the Examiner's rejection has been overcome or rendered moot in view of the Inventor's supplemental declaration submitted herewith, for the reasons set forth below.

Applicant reminds the Examiner that a rejection under 35 U.S.C. § 102(e) is only proper if the reference teaches each and every element of the claimed invention, and if the reference has an effective priority date prior to the date of Applicant's claimed invention. Such is not the case here. Applicant reminds the Examiner that Mack does not disclose SEQ ID NO:4 of

the present application prior to Applicant's invention of SEQ ID NO:4, as evidenced by Applicant's supplemental declaration under 37 C.F.R. § 1.131, submitted herewith.

First, the Examiner has rejected the declaration previously submitted under 37 C.F.R. § 1.131 as not providing sufficient factual and identifying information so as to establish that the claimed SEQ ID NO:4 was in fact invented prior to the earliest priority date of Mack. Applicant has therefore provided extensive factual and identifying information related to the specific identification and characterization of SEQ ID NO:4, set forth in paragraphs 6 and 7 in the accompanying supplemental declaration under 37 C.F.R. § 1.131.

Applicant has not provided the exact date of conception in the declaration, but instead, has properly made the assertion that the invention was indeed made prior to the earliest priority date of Mack. Specifically, the sequence determination of SEQ ID NO:4 of the present invention is a reduction to practice of the invention.

MPEP §§ 715.07 and 715.07(a) require that the declarant merely allege that the invention was made before the earliest priority date of the cited prior art, and that this allegation is sufficient proof for the purpose of the declaration under 37 C.F.R. § 1.131. Further, MPEP §§ 715.07 and 715.07(a) sets forth that exact dates of invention need only be provided when diligence must be demonstrated between the times of conception and reduction to practice of the invention. Because Applicant's reduction to practice occurred prior to the earliest priority date of Mack, Applicant is not required to provide exact dates of invention, but rather, need only make the appropriate allegation, as has been done in the supplemental declaration under 37 C.F.R. § 1.131 submitted herewith.

The Examiner also rejected the previously-submitted declaration as insufficient for failing to indicate that the acts of the inventor were carried out in the United States, a NAFTA country or a WTO member country. In paragraph 8 of the supplemental declaration, the inventor establishes that the invention was indeed made in the United States, in satisfaction of the requirement set forth in MPEP § 715.07(c).

Finally, as set forth above, Applicant has amended the inventorship of the presently-claimed invention to reflect that Volkhard Lindner is the sole inventor of the presently-claimed invention. Therefore, only Volkhard Lindner is required to sign the supplemental declaration under 37 C.F.R. § 1.131, in compliance with 37 C.F.R. § 715.04.

Accordingly, in view of the present arguments and the supplemental declaration submitted under 37 C.F.R. § 1.131, the Mack reference cannot properly anticipate the present

invention because the invention set forth in the Mack reference was not made prior to Applicant's presently-claimed invention. Reconsideration and withdrawal of the Examiner's rejection of claims 21, 37 and 43 pursuant to 35 U.S.C. §102(e), is respectfully requested.

Summary

Applicant respectfully submits that the claims currently under consideration are in full condition for allowance. Favorable examination of the claims on the merits and notification of allowance at the earliest possible time is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

**VOLKHARD LINDNER**

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Date

By:



THOMAS M. SOSSONG, JR., Ph.D., J.D.

Registration No. 48,463

DRINKER BIDDLE & REATH, LLP

One Logan Square

18<sup>th</sup> & Cherry Streets

Philadelphia, PA 19103-6996

Telephone: (215) 988-2700

**Direct Dial: (215) 988-2562**

Facsimile: (215) 988-2757

E-Mail: thomas.sossong@dbr.com

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